

REMARKS

Claims 13, 14, 18, 21, 23, 27, 34 and 37 have been amended. Claims 42 is new. Upon entry of this amendment, claims 13, 14, 18, 21, 23, 25 and 27-41 will be pending in the above-identified application. Support for new Claim 42 can be found at, for example, Figure 10 at PR2 and page 19 of the specification, line 11 and following.

Claim Rejections Under 35 U.S.C. § 112

Applicants request reconsideration of the rejection of claims 34-37, 39 and 41 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant respectfully reiterates prior argument with clarifications (based on Examiner comment in Advisory Action of May 24) and respectfully requests Examiner reconsider.

Examiner argues that claims 35, 39, and 41 are unclear due to the term "detachably connecting." The Office argues that this means both attached and detached. Applicant believes this term is perfectly clear and denotes that the attached part can be detached, not that it is detached. Applicant notes that "detachably" is used as an adverb. Applicant further notes that "detachably" as used herein has been condoned by the courts (*In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967)) and is cited in the MPEP at 2115. The Examiner has noted that the use of detachably in 2215 is different from the use in the instant invention. Applicant respectfully disagrees, and believes the term is used in almost exactly the same manner. MPEP 2115 recites:

In In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967), an apparatus claim recited "[a] taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere"

"Detachably" is used in the Casey case to defined how the tape is attached (for example, the tape can be detached, removed, and the attachment of the tape is non-permanent).

Applicant adds to this argument by further stating that detachably is the adverb form of "detach" which means "to unfasten and separate; disengage; disunite." Adverbs typically express some relation of place, time, manner, attendant circumstance, degree, cause, inference, result, condition, exception, concession, purpose, or means. The use of the term detachably is clear, concise and clearly falls within the understood use of an adverb, and its usage in this context has been approved by the courts. Applicant again respectfully requests reconsideration and withdrawal of this rejection. In order to hasten prosecution Applicant would be willing to define "connected" as "non-permanently connected" instead of "detachably connected," but Applicant respectfully believes "detachably" better conveys the intended meaning.

Examiner argues that claim 34 is unclear. Applicant respectfully believes that argument presented in prior Amendment and Response should have been persuasive, but in order to hasten prosecution Applicant has modified claim 34 to define where the profile information is stored, solely to hasten prosecution.

Examiner argues that claim 37 is unclear do to the phrase "information corresponding to the use of each terminal unit." Applicant respectfully disagrees and believe the phrase is clear, but the Applicant has modified this phrase solely to hasten prosecution.

Claim Rejections Under 35 U.S.C. § 103

Applicants request reconsideration of the rejection of claims 13, 14, 18, 21, 23, 25, 27-33, 38 and 40 under 35 U.S. C. §103(a) as being unpatentable over by Dedrick (U.S. pat. No. 5,717,923) in view of Lee et al. (U.S. Pat. No. 6,751,459).

A *prima facie* case of obviousness is established when three basic criteria have been met. First, there must be some suggestion or reason, either in the prior art cited by the Examiner or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the references being relied upon to reject the claimed

invention. Second, there must be a reasonable expectation of success. Third, the prior art reference or combination of references must teach or suggest all of the requirements of the claimed invention. MPEP 2143. In the instant case, the cited art fails to teach each and every limitation, there is not a reasonable expectation of success, and there is no motivation in the references to combine them. Further, the simple citation to each and every element in a claim does not suffice to maintain a rejection. The Supreme Court has specifically held that the "A patent composed several elements is not proved obvious by demonstrating that each element was, independently, known in the prior art." *KSR v Teleflex*, 500 U.S. _____ (2007).

Generally, Dedrick teaches;

"A method and apparatus for dynamically customizing electronic information to individual end users includes a client system containing a personal profile database which stores consumer information corresponding to individual end user(s) of the client system. The client system also includes a content adapter which compares electronic information received by the client system to the consumer information in the personal profile database and customizes the electronic information to an individual end user based on this comparison. The client system also includes a client activity monitor which monitors actions taken by an individual end user when consuming electronic information and updates the personal profile database based on these actions. In one embodiment, the client activity monitor also monitors which actions are ignored by the individual end user and updates the personal profile database based on the consumer's interaction with the electronic information (that is, both the consumer's action and inaction). In one embodiment, an electronic information server containing a plurality of electronic information units is coupled to the client system via an electronic information distribution network and serves as the source of the electronic information." Abstract.

Generally Lee teaches;

"A method and apparatus for dynamically customizing electronic information to individual end users includes a client system containing a personal profile database which stores consumer information corresponding to individual end user(s) of the client system. The client system also includes a content adapter which compares electronic

information received by the client system to the consumer information in the personal profile database and customizes the electronic information to an individual end user based on this comparison. The client system also includes a client activity monitor which monitors actions taken by an individual end user when consuming electronic information and updates the personal profile database based on these actions. In one embodiment, the client activity monitor also monitors which actions are ignored by the individual end user and updates the personal profile database based on the consumer's interaction with the electronic information (that is, both the consumer's action and inaction). In one embodiment, an electronic information server containing a plurality of electronic information units is coupled to the client system via an electronic information distribution network and serves as the source of the electronic information." Abstract.

In the Advisory Action the Examiner states that detachably connected is taught by Dedrick and Lee, but points to no teaching within either reference. This leaves the Applicant to prove a negative. This is not appropriate under the standards of the Office. The MPEP states at 2143.03 that "All the limitations of a claim must be considered when weighing the difference between the claimed invention and the prior art..." and further states at MPEP 2142 that "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." The general statement that Examiner believes Dedrick and Lee do teach such a device, when they clearly do not mention a detachable device does not suffice. Applicant requests factual support of the Examiner's position as required by the Office and the courts. MPEP 2142, *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

If the Examiner is arguing equivalence of the Dedrick and Lee devices to the detachable device in the instant claims, the Examiner is required to use the standard as described in MPEP 2183:

"If the examiner finds that a prior art element

(A) performs the function specified in the claim,

(B) is not excluded by any explicit definition provided in the specification for an equivalent, and

(C) is an equivalent of the means- (or step-) plus-function limitation,

the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent."

The Examiner has provided no specific support for their position as is required (the burden to support the *prima facie* case of obviousness is on the Examiner), thus Examiner argument is nearly impossible to refute as Applicant believes that these references do not teach a detachable device, and the Examiner has provided no specific support.

Neither Dedrick nor Lee teach a detachable device. A detachable device allows the information to be mobile and used differently by the collector of said information. All claims reciting this patentable distinction are allowable, and Applicant requests such allowance of claims 13, 14, 18, 21, 23, 27, 35, 37, 39, and 41. Applicant allows requests allowance of claims depending therefrom which include claims 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, and 40.

Regarding claim 13, as to the limitation "a terminal unit for use by a user adapted for accumulating terminal use record information upon use of said terminal unit by said user and original profile information of said user generated on the basis of said terminal use record information" is not taught by Dedrick, even when supplemented by Lee. The MPEP states at 2143.03 that "All the limitations of a claim must be considered when weighing the difference between the claimed invention and the prior art..." The Applicant need only show that one limitation in the claim is novel and nonobvious, Applicant need not argue each and every limitation present in a claim as implied by the Examiner in the Advisory Action. Each element in Claim 13 is not taught. Dedrick and Lee define characteristics of server computers that are distant from the user, not the terminal employed by the user (for example, see the Figures for proposed embodiments

in Dedrick). This is a patentable distinction, and thus claim 13 and all claims depending therefrom are novel and nonobvious. In fact this limitation is primary to the invention embodied in claim 13. Dedrick also does not teach comparing the collected information with the original profile, but instead with a other information through a "content adapter." This deficiency is not addressed by Lee.

Regarding claims 14 and 18, the recitation of "selecting means selects said provided information on the basis of said new profile information written in said storing means" is a patentable distinction which makes claim 14 and all claims which recite this limitation, or depend from claims which recite it, patentable. This is not taught by Dedrick, even as supplemented by Lee. Dedrick teaches "The client system also includes a content adapter which compares electronic information received by the client system to the consumer information in the personal profile database and customizes the electronic information to an individual end user based on this comparison." Dedrick teaches only to use the entire profile information in the database to select information provided to the user, not the differential use of "new" profile information. This deficiency is not supplemented by Lee. Claims 14 and 18 are allowable based on this patentable distinction.

As to the Office's claim that GPS data is taught by column 17, lines 1-15 of Dedrick, Applicant respectfully disagrees. The lines are:

Thus, the method and apparatus of the present invention provides individual end users with high quality electronic information while preserving the end users' privacy. The user profile data corresponding to individual end users is stored in the client systems of those end users. Statistics regarding the psychographic, demographic and other profile characteristics of these users is returned to publishers and advertisers, however the information returned to these publishers and advertisers has no information to identify the identity of the end users. Thus, publishers and advertisers are able to provide the type of electronic information that end users want, thereby providing high quality electronic information. In addition, the client systems which the individual end users utilize are able to customize the electronic information to the individual end users based on the user profile data stored in the client systems.

Applicant asks for reconsideration an allowance of claims 28-33 as GPS in not taught, mentioned, or contemplated by the reference. In fact in the quote specifically cited by the Examiner, the reference particularly notes that "no information to identify the identity of end users" is provided and a goal of the invention is "preserving end users privacy." This would teach away from such specific location information as can be provided by GPS.

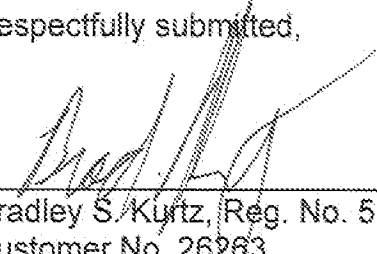
Conclusion

Applicant respectfully requests withdrawal of the objections/rejections and believes that the claims as presented represent allowable subject matter. If the Examiner desires, applicant welcomes a telephone interview to expedite prosecution and is available at the telephone number below.

Applicant believes there is a \$120 fee due at this time for a one month extension of time. However, the Commissioner is hereby authorized to deduct any deficiency or credit any overpayment to Deposit Account No. 19-3140.

Respectfully submitted,

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